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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,473	01/03/2001	Christophe Fletout	00856/TL	1823

7590

07/03/2002

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EXAMINER

LEE, DIANE I

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 07/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/753,473

Applicant(s)

FLETOUT ET AL.

Examiner

Diane I. Lee

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4 and 5 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

**DETAILED ACTION**

1. Claims 1-5 are presented for examination.
2. Receipt is acknowledged that the DE-196 40 26 A reference was cited in PCT international search report as an "X" reference.

***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 1-2 and 4-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claims 1-2 and 4-5: The use of an alternate language such as "the connection terminals and/or the conductive track" renders the claim vague and indefinite. The limitation must be clear. For examining purpose, the limitation has been translated to -- the connection terminals or the conductive track--.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischbach [DE-196 40 260 A1, cited by the applicant].

Fischbach discloses an antenna (an induction coil 3) for an integrated circuit card, the antenna comprising a conductive track (see figures 1-5) forming at least one turn and having ends comprising conductive layers forming connection terminal (coil pads 5, 7), wherein each of the connection terminals having a perforation (i.e., a circular hole 5).

Fischbach does not specifically the connection terminals having a plurality of perforation.

Since Fischbach teaches that the aperture is to pass the contact terminal (i.e., lead frame contact 4), it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to provide a plurality of perforations as an additional aperture for the lead frame contact to pass through and/or solder. Such modification would have provided a greater contact between the connection terminal and the lead contact frame within the card. Furthermore, it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

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Re claim 2: wherein the connection terminal and/or the conductive track have slots in the form of strips (see figures 1 and 5).

Re claim 4: since Fischbach teaches the plurality of circular holes on the connection terminals, any regular formation of the holes on the connection terminal would obviously forms an array of holes.

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fischbach in view of Fidalgo [US 5,598,032]. The teachings of Fischbach have been discussed above.

Although Fischbach shows the portion of the integrated circuit card having a card body having film which serves as an insulating material and the material surrounding the antenna extending through the perforations in the connection terminals; he does not explicitly shows the integrated circuit card having a integrated circuit module received in a cavity.

Fidalgo shows an integrated circuit card having a card body of insulating material (thermoplastic sheet 3, 4) in which there is embedded antenna and an integrated circuit module 7 received in a cavity 17 of the card body and provided with internal connection areas 15 connected to the connection terminals of the antenna (see figures 1-9).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to provide the embedded antenna and an integrated circuit module molded in the card body as taught by Fidalgo in the card body structure of the Fischbach in order to provide a card that is slim and aesthetically pleasing.

***Allowable Subject Matter***

10. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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11. The following is a statement of reasons for the indication of allowable subject matter: the best prior art of the record, Fischbach, fails to teach or fairly suggest the slots of the connection terminals and/or the conductive track are of undulating outline, as set forth in the claim.

*Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

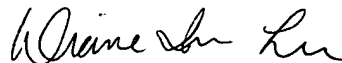
Campbell et al. [US 3,653,052] and Uchimura et al. [US 6,064,350] disclose an antenna having a conductive track with a plurality of perforations.

Gabrelian et al. [US 5,737,698] discloses a perforated conductor.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane I. Lee whose telephone number is 703-306-3427. The examiner can normally be reached on Monday through Friday from 6:30 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



Diane I. Lee  
Primary Examiner  
Art Unit 2876

June 25, 2002